<u>REMARKS</u>

In the Office Action, dated July 5, 2006, the Examiner rejected claims 1, 2, 5-21 and 24-29 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,990,633 (hereinafter "MIYASAKA") and rejected claims 3, 4, 22 and 23 as allegedly being unpatentable over MIYASAKA in view of U.S. Patent Application Publication No. 2002/0103809 (hereinafter "STARZL"). Applicants respectfully traverse the rejection of the claims under 35 U.S.C. § 102 and 35 U.S.C. § 103.[1]

By way of this amendment, Applicants have amended claim 10 to incorporate the subject matter of dependent claim 13 and to improve form. Claims 1, 14, 15, 17-19 and 29 have been amended to improve form. Claim 13 has been canceled without prejudice or disclaimer. Reconsideration of the outstanding rejections of pending claims 1-12 and 14-29 is respectfully requested in view of the following remarks.

<u>R<small>EJECTIONS</small> U<small>NDER</small> 35 U.S.C. §102</u>

On page 2, the Office Action rejects pending claims 1, 2, 5-12, 14-21 and 24-29 under 35 U.S.C. §102(e) as allegedly being anticipated by MIYASAKA. Applicants respectfully traverse.

Amended independent claim 1, for example, recites a method that includes "hosting first news content at a first news server," "receiving user input selecting news content of the first

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[1] As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such assertions/requirements in the future.

news content," "sending query data, associated with the selected news content, to the news aggregation server," "receiving, at the first news server via a network, second news content from the news aggregation server resulting from a search performed at the news aggregation server using the query data" and "hosting the second news content, in conjunction with the first news content, at the first news server."

A proper rejection under 35 U.S.C. § 102 requires that a reference teach every aspect of the claimed invention. Any feature not directly taught must be inherently present. In other words, the identical invention must be shown in as complete detail as contained in the claim. See M.P.E.P. § 2131. MIYASAKA does not disclose or suggest the combination of features recited in Applicants' amended claim 1.

For example, MIYASAKA does not disclose or suggest "hosting first news content at a first news server," "sending query data, associated with the selected news content, to the news aggregation server over a network," "receiving, at the first news server via a network, second news content from the news aggregation server resulting from a search performed at the news aggregation server using the query data" and "hosting the second news content, in conjunction with the first news content, at the first news server." The Office Action (pgs. 1-2) relies on column 3, line 30; column 3, lines 43-45; and column 4, lines 29-40 of MIYASAKA for allegedly disclosing the features of claim 1. Applicants respectfully submit that these sections of MIYASAKA do not disclose or suggest the above-noted features of claim 1.

At column 3, lines 16-37, MIYASAKA discloses:

FIG. 1A is a block diagram of method 30 that may be used to carry out various aspects of a first process that provides a computer-network based newspaper

     having content that can be selected and presented in a form according to personal preferences of an individual recipient. According to this method, step 31 obtains profile information from the individual that defines that individual's personal preferences. In one implementation, the profile includes indications of desired topics for news articles, a selected layout for presentation, and a schedule for providing the newspaper. In this implementation, step 32 and subsequent steps are performed at times specified by the recipient's chosen schedule. Step 32 searches for documents having content that matches the indications of desired topics, and step 33 obtains the content of the documents identified by the search. Step 34 generates a representation of the content of these documents in a format or layout specified in the recipient's profile. Optionally, method 30 includes step 35 that delivers the representation to a destination specified by the recipient. For example, step 35 may send the generated representation by electronic mail (e-mail) to an address included in the profile.

This section of MIYASAKA discloses a process that searches for documents having content that matches the personal preferences of an individual recipient. The process of MIYASAKA obtains the content of the documents identified by the search and delivers the content to the recipient (e.g., via email). This section of MIYASAKA, thus, discloses a news search server obtaining news content for an individual recipient via a document search and delivering the obtained content to the individual recipient. This section of MIYASAKA does not disclose, or even suggest, the interaction of two servers over a network, where a first news server hosts first news content, where a news aggregation server returns second news content resulting from a search performed at the news aggregation server using query data, and where the first news server receives the second news content via a network and hosts the second news content in conjunction with the first news content. MIYASAKA, thus, does not disclose, or even suggest, "hosting first news content at a first news server," "sending query data, associated with the selected news content, to the news aggregation server over a network," "receiving, at the

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first news server via a network, second news content from the news aggregation server

resulting from a search performed at the news aggregation server using the query data"

and "hosting the second news content, in conjunction with the first news content, at the

first news server," as recited in amended claim 1.

At column 3, lines 38-53, MIYASAKA discloses:

FIG. 1B is a schematic diagram of computer and network components that may be used to carry out various aspects of the present invention according to method 30. In the example shown, information received from recipient 41 is used to construct one or more records of recipient preferences in profile database 42. Search 43 identifies documents in content database 44 having content that matches indications of desired topics in the recipient preferences. A representation of the content of those documents identified by the search is generated by format 47 in a form that conforms to a layout selected from layout database 46 by select 45 according to recipient preferences. In a preferred implementation, deliver 48 sends the formatted representation to recipient 41. In an alternative implementation, the representation is stored for delivery to recipient 41 in response to an explicit request.

This section of MIYASAKA discloses a search process 43 that identifies documents in a

content database 44 that match the preferences of an individual recipient 41. A delivery

process 48 delivers a formatted representation of the content to the individual recipient

41. Similar to the discussion above, this section of MIYASAKA does not disclose or

suggest, a first news server that hosts first news content, a news aggregation server that

returns second news content resulting from a search performed at the news aggregation

server using query data, and where the first news server receives the second news content

via a network and hosts the second news content in conjunction with the first news

content. MIYASAKA, thus, does not disclose, or even suggest, "hosting first news

content at a first news server," "sending query data, associated with the selected news

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content, to the news aggregation server, wherein the news aggregation server is a

different network entity than the first news server," "receiving, at the first news server via

a network, second news content from the news aggregation server resulting from a search

performed at the news aggregation server using the query data" and "hosting the second

news content, in conjunction with the first news content, at the first news server," as

recited in amended claim 1.

At column 4, lines 27-43, MIYASAKA discloses:

FIG. 3 provides a schematic illustration of a computer network in which various aspects of the present invention may be carried out. In the example shown, news server 5 performs the services described above and illustrated in FIGS. 1A, 1B, 2A and 2B. News server 5 obtains documents by subscription through network 1 from content provider 4 and stores these documents in content database 44. Alternatively or in addition, news server 5 may search for and obtain the content of individual documents from databases or other repositories that are maintained by content provider 4 or others. News server 5 formats the content of these documents to provide to each recipient computer system 7 - 9 a representation of a customized newspaper having content that may be presented according to recipient preferences. Optionally, news server 5 may send the representation to each recipient according to individual scheduling preferences.

This section of MIYASAKA discloses a news server 5 that obtains documents from

content provider 4, or searches for and obtains document content from databases or other

repositories that are maintained by content provider 4. As disclosed in MIYASAKA,

news server 5 provides a representation of a newspaper, using document content from

content provider 4, to individual recipients 7, 8 or 9 based on individual scheduling

preferences. Similar to the discussion above, this section of MIYASAK does not disclose

or suggest, a first news server that hosts first news content, a news aggregation server that

returns second news content resulting from a search performed at the news aggregation

server using query data, and where the first news server receives the second news content

via a network and hosts the second news content in conjunction with the first news

content. MIYASAKA, thus, does not disclose, or even suggest, "hosting first news

content at a first news server," "sending query data, associated with the selected news

content, to the news aggregation server, wherein the news aggregation server is a

different network entity than the first news server," "receiving, at the first news server via

a network, second news content from the news aggregation server resulting from a search

performed at the news aggregation server using the query data" and "hosting the second

news content, in conjunction with the first news content, at the first news server," as

recited in amended claim 1.

For at least the foregoing reasons, Applicants submit that amended claim 1 is not

anticipated by MIYASAKA. Withdrawal of the rejection of claim 1 under 35 U.S.C. §102 is

respectfully requested.

Claims 2 and 5-9 depend from claim 1. These claims, therefore, patentably distinguish

over MIYASAKA for at least the reasons set forth above with respect to claim 1.[2]

Amended independent claim 10 recites a "method of creating custom news documents"

that includes "periodically producing one or more custom search queries related to news of

interest," "sending the one or more search queries at periodic intervals across a network to a

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[2] As Applicants' remarks with respect to the base independent claims are sufficient to overcome the Examiner's
rejections of all claims dependent therefrom, Applicants' silence as to the Examiner's assertions with respect to
dependent claims is not a concession by Applicants to the Examiner's assertions as to these claims, and Applicants
reserve the right to analyze and dispute such assertions in the future.

news search server that aggregates news from a plurality of news sources," "receiving news content corresponding to the one or more search queries from the news search server," "inserting the news content into the custom news documents, wherein the custom news documents are stored at a custom news server that is remote from the news search server" and "permitting access to a plurality of clients, from across the network, to the custom news documents." Applicants respectfully submit that MIYASAKA does not disclose or suggest the combination of features recited in amended claim 10.

For example, MIYASAKA does not disclose or suggest, among other features, "inserting the news content into the custom news documents, wherein the custom news documents are stored at a custom news server that is remote from the news search server" and "permitting access to a plurality of clients, from across the network, to the custom news documents." The Office Action (pgs. 4-5) relies on FIG. 5E; column 4, lines 34-37; column 4, lines 9-12; column 3, lines 45-49; FIG. 3; and column 3, line 67 – column 4, line 2 of MIYASAKA for allegedly disclosing the features of amended claim 10. Applicants submit that these sections of MIYASAKA do not disclose or suggest the above-noted features of amended claim 10.

With regard to FIG. 5E, MIYASAKA discloses a step for user registration that includes specifying when the individual recipient wishes to receive newspaper content. As shown in FIG. 5E, the individual recipient may specify how often the newspaper content is to be delivered, and a specific time (including a time zone) at which the newspaper content is to be delivered. FIG. 5E of MIYASAKA, however, does not disclose or suggest "inserting the news content into the

custom news documents, wherein the custom news documents are stored at a custom news server

that is remote from the news search server" and "permitting access to a plurality of clients, from

across the network, to the custom news documents," as recited in amended claim 10.

At column 4, lines 34-37, MIYASAKA discloses:

Alternatively or in addition, news server 5 may search for and obtain the content
of individual documents from databases or other repositories that are maintained
by content provider 4 or others.

This section of MIYASAKA merely discloses that a news server 5 may search content

maintained by a content provider 4 to obtain newspaper content. This section of MIYASAKA,

however, does not disclose, or even suggest, that news server 5 obtains news content and then

inserts the news content into custom news documents stored at another server that is remote from

news server 5, where the custom news documents stored at the remote server may subsequently

be accessed by a plurality of clients. This section of MIYASAKA, thus, does not disclose or

suggest "inserting the news content into the custom news documents, wherein the custom news

documents are stored at a custom news server that is remote from the news search server" and

"permitting access to a plurality of clients, from across the network, to the custom news

documents," as recited in amended claim 10.

At column 4, lines 9-12, MIYASAKA discloses:

Search 63 identifies one or more documents in content database 44 having content
that matches indications of desired topics in the recipient preferences.

This section of MIYASAKA merely discloses a search 63 being performed by news server 5 that

identifies documents in content database 44 that include content that matches an individual

recipient's preferences. This section of MIYASAKA, however, does not disclose, or even

suggest, "inserting the news content into the custom news documents, wherein the custom news documents are stored at a custom news server that is remote from the news search server" and "permitting access to a plurality of clients, from across the network, to the custom news documents," as recited in amended claim 10.

At column 3, lines 45-49, MIYASAKA discloses:

A representation of the content of those documents identified by the search is generated by format 47 in a form that conforms to a layout selected from layout database 46 by select 45 according to recipient preferences.

This section of MIYASAKA merely discloses that content of the documents identified by a search process by a news server 5 may be generated using a layout selected according to the recipient's preferences. This section of MIYASAKA, however, does not disclose or suggest "inserting the news content into the custom news documents, wherein the custom news documents are stored at a custom news server that is remote from the news search server" and "permitting access to a plurality of clients, from across the network, to the custom news documents," as recited in amended claim 10.

With regard to FIG. 3, MIYASAKA generally discloses the network entities that are involved in the newspaper generation process disclosed by MIYASAKA. As shown in FIG. 3, these network entities include a news server 5, a content provider 4 and individual recipients 7, 8 and 9. As discussed above, news server 5 searches content stored at content provider 4 to generate newspaper content that may then be provided to client devices associated with each individual recipient 7, 8 or 9. This section of MIYASAKA, however, does not disclose, or even suggest, that news server 5 obtains news content and then inserts the news content into custom

news documents stored at another server that is remote from news server 5, where the custom

news documents stored at the remote server may subsequently be accessed by a plurality of

clients. This section of MIYASAKA, thus, does not disclose or suggest "inserting the news

content into the custom news documents, wherein the custom news documents are stored at a

custom news server that is remote from the news search server" and "permitting access to a

plurality of clients, from across the network, to the custom news documents," as recited in

amended claim 10.

At column 3, line 67 – column 4, line 2, MIYASAKA discloses:

Step 56 generates a representation of the content of these selected documents in a
format or layout specified in the recipient's profile.

This section of MIYASAKA discloses the generation of a newspaper having content in a layout

specified by an individual recipient's profile. This section of MIYASAKA, however, does not

disclose, or even suggest, "inserting the news content into the custom news documents, wherein

the custom news documents are stored at a custom news server that is remote from the news

search server" and "permitting access to a plurality of clients, from across the network, to the

custom news documents," as recited in amended claim 10.

In view of the remarks above, Applicants respectfully submit that MIYASAKA does not

disclose or suggest the combination of features recited in amended claim 10. Withdrawal of the

rejection of this claim is, therefore, requested.

Claims 11 and 12 depend from claim 10. These claims, therefore, patentably distinguish

over MIYASAKA for at least the reasons set forth above with respect to claim 10.

Amended independent claim 14 recites similar features to (though possibly of different scope than) features recited in claim 10. Claim 14, therefore, patentably distinguishes over MIYASAKA for similar reasons to those set forth above with respect to claim 10.

Amended independent claim 15 recites a method that includes "fetching news content from a plurality of news source servers," "aggregating the news content," "periodically receiving one or more search queries across a network from an external server that hosts customized news content," "searching the aggregated news content based, at least in part, on the one or more search queries" and "periodically providing news content to the external server based on results of the searches." Applicants respectfully submit that MIYASAKA does not disclose or suggest the combination of features recited in amended claim 15.

For example, MIYASAKA does not disclose or suggest "periodically receiving one or more search queries across a network from an external server that hosts customized news content," "searching the aggregated news content based, at least in part, on the one or more search queries" and "periodically providing news content to the external server based on results of the searches," as recited in amended claim 15. The Office Action (pg. 5) cites to column 4, lines 29-40; column 3, lines 29-31 and FIG. 3 of MIYASAKA for allegedly disclosing the various features of claim 15. Applicants submit that the sections of MIYASAKA cited by the Office Action do not disclose or suggest the above-noted features of amended claim 15.

As discussed above with respect to claim 1, column 4, lines 29-40 of MIYASAKA discloses a news server 5 that obtains documents from content provider 4, or searches for and obtains document content from databases or other repositories that are maintained by content

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provider 4. As disclosed in MIYASAKA, news server 5 provides a representation of a newspaper, using document content from content provider 4, to individual recipients 7, 8 or 9 based on individual scheduling preferences. This section of MIYASAKA, however, does not disclose or suggest "periodically receiving one or more search queries across a network from an external server that hosts customized news content," "searching the aggregated news content based, at least in part, on the one or more search queries" and "periodically providing news content to the external server based on results of the searches," as recited in amended claim 15.

As further discussed above with respect to claim 1, column 3, lines 29-31 of MIYASAKA merely discloses a process that searches for documents having content that matches the personal preferences of an individual recipient. This section of MIYASAKA, however, does not disclose or suggest "periodically receiving one or more search queries across a network from an external server that hosts customized news content," "searching the aggregated news content based, at least in part, on the one or more search queries" and "periodically providing news content to the external server based on results of the searches," as recited in amended claim 15.

As also discussed above with respect to claim 10, FIG. 3 merely depicts the network entities that are involved in the newspaper generation process disclosed by MIYASAKA. As shown in FIG. 3, these network entities include a news server 5, a content provider 4 and individual recipients 7, 8 and 9. As discussed above, news server 5 searches content stored at content provider 4 to generate newspaper content that may then be provided to client devices associated with each individual recipient 7, 8 or 9. FIG. 3, however, does not disclose, or even

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suggest, "periodically receiving one or more search queries across a network from an external server that hosts customized news content," "searching the aggregated news content based, at least in part, on the one or more search queries" and "periodically providing news content to the external server based on results of the searches," as recited in amended claim 15.

In view of the remarks above, Applicants submit that MIYASAKA does not disclose or suggest the combination of features recited in amended claim 15. Withdrawal of the rejection of claim 15 is, therefore, respectfully requested.

Claim 16 depends from claim 15. Withdrawal of the rejection of claim 16 is, therefore, requested for at least the reasons set forth above with respect to claim 15.

Amended independent claim 17 recites a "system for providing client access to customized news content" that includes "a custom news server configured to: periodically send one or more customized search queries across a network to a news search server" and "wherein the news search server is configured to: store news content from a plurality of news source servers, periodically receive the one or more search queries from the custom news server, search the stored news content based on the one or more search queries, and periodically provide news content to the custom news server based on results of the searches; wherein the custom news server is further configured to permit access to a plurality of clients, from across the network, to the news content provided by the news search server." Applicants respectfully submit that MIYASAKA does not disclose or suggest the combination of features recited in amended claim 17.

For example, MIYASAKA does not disclose or suggest "a custom news server configured to periodically send one or more customized search queries across a network to a news search server," "wherein the news search server is configured to: ….search the stored news content based on the one or more search queries, and periodically provide news content to the custom news server based on the results of the searches," "wherein the custom news server is further configured to permit access to a plurality of clients, from across the network, to the news content provided by the news search server," as recited in amended claim 17. The Office Action (pgs. 5-6) relies on FIG. 5E; column 4, lines 34-37; column 3, lines 29-31; FIG. 3 and column 3, line 67 – column 4, line 2 of MIYASAKA for allegedly disclosing the various features of claim 17. Applicants submit that these sections of MIYASAKA do not disclose or suggest the above-noted features of amended claim 17.

As discussed above with respect to claim 10, FIG. 5E of MIYASAKA merely discloses a process step for user registration that includes specifying when the individual recipient wishes to receive newspaper content. As shown in FIG. 5E, the individual recipient may specify how often the newspaper content is to be delivered, and a specific time (including a time zone) at which the newspaper content is to be delivered. FIG. 5E does not disclose or suggest "a custom news server configured to periodically send one or more customized search queries across a network to a news search server," "wherein the news search server is configured to: ….search the stored news content based on the one or more search queries, and periodically provide news content to the custom news server based on the results of the searches," "wherein the custom news server is

further configured to permit access to a plurality of clients, from across the network, to the news content provided by the news search server," as recited in amended claim 17.

As further discussed above with respect to claim 10, column 4, lines 34-37 of MIYASAKA merely discloses that a news server 5 may search content maintained by a content provider 4 to obtain newspaper content. This section of MIYASAKA does not disclose or suggest "a custom news server configured to periodically send one or more customized search queries across a network to a news search server," "wherein the news search server is configured to: ….search the stored news content based on the one or more search queries, and periodically provide news content to the custom news server based on the results of the searches," "wherein the custom news server is further configured to permit access to a plurality of clients, from across the network, to the news content provided by the news search server," as recited in amended claim 17.

As also discussed above with respect to claim 1, column 3, lines 29-31 of MIYASAKA discloses a process that searches for documents having content that matches the personal preferences of an individual recipient. This section of MIYASAKA does not disclose or suggest "a custom news server configured to periodically send one or more customized search queries across a network to a news search server," "wherein the news search server is configured to: ….search the stored news content based on the one or more search queries, and periodically provide news content to the custom news server based on the results of the searches," "wherein the custom news server is further configured to permit access to a plurality of clients, from

across the network, to the news content provided by the news search server," as recited in

amended claim 17.

As further discussed above with respect to claim 10, FIG. 3 of MIYASAKA depicts the

network entities that are involved in the newspaper generation process disclosed by

MIYASAKA. As shown in FIG. 3, these network entities include a news server 5, a content

provider 4 and individual recipients 7, 8 and 9. News server 5 of MIYASAKA, as discussed

above, searches content stored at content provider 4 to generate newspaper content that may then

be provided to client devices associated with each individual recipient 7, 8 or 9. This section of

MIYASAKA does not disclose or suggest "a custom news server configured to periodically send

one or more customized search queries across a network to a news search server," "wherein the

news search server is configured to:....search the stored news content based on the one or more

search queries, and periodically provide news content to the custom news server based on the

results of the searches," "wherein the custom news server is further configured to permit access

to a plurality of clients, from across the network, to the news content provided by the news

search server," as recited in amended claim 17.

As also discussed above with respect to claim 10, column 3, line 67 – column 4, line 2 of

MIYASAKA discloses the generation of a newspaper having content in a layout specified by an

individual recipient's profile. This section of MIYASAKA does not disclose or suggest "a

custom news server configured to periodically send one or more customized search queries

across a network to a news search server," "wherein the news search server is configured

to:....search the stored news content based on the one or more search queries, and periodically

provide news content to the custom news server based on the results of the searches," "wherein the custom news server is further configured to permit access to a plurality of clients, from across the network, to the news content provided by the news search server," as recited in amended claim 17.

In view of the remarks above, Applicants submit that MIYASAKA does not disclose or suggest the combination of features recited in amended claim 17. Withdrawal of the rejection of this claim is, therefore, respectfully requested.

Amended independent claim 18 recites similar features to (though possibly of different scope than) features recited in claim 1. Claim 18, therefore, patentably distinguishes over MIYASAKA for similar reasons to those set forth above with respect to claim 1.

Amended independent claim 19 recites a "method of retrieving news content from a news server" that includes "permitting client access, via a network, to first news content contained in one or more news documents stored at a custom document server," "sending query data from the custom document server across the network to the news server based, at least in part, on a portion of the first news content that is accessed by the client," "receiving second news content, via the network, at the custom document server from the news server based, at least in part, on the query data," "incorporating the second news content into the one or more news documents" and "permitting client access, via the network, to the second news content at the custom document server." Applicants submit that MIYASAKA does not disclose or suggest the combination of features recited in amended claim 19.

For example, MIYASAKA does not disclose or suggest "receiving second news content, via the network, at the custom document server from the news server based, at least in part, on the query data," "incorporating the second news content into the one or more news documents" and "permitting client access, via the network, to the second news content at the custom document server," as recited in amended claim 19. The Office Action (pgs. 6-7) cites to FIG. 3; column 3, line 67 – column 4, line 2; and column 4, lines 29-40 of MIYASAKA for allegedly disclosing the various features of claim 19. Applicants submit that these sections of MIYASAKA do not disclose or suggest the above-noted features of amended claim 19.

As discussed above with respect to claim 10, FIG. 3 of MIYASAKA depicts the network entities that are involved in the newspaper generation process disclosed by MIYASAKA. As shown in FIG. 3, these network entities include a news server 5, a content provider 4 and individual recipients 7, 8 and 9. As further discussed above, news server 5 searches content stored at content provider 4 to generate newspaper content that may then be provided to client devices associated with each individual recipient 7, 8 or 9. FIG. 3 of MIYASAKA, therefore, does not disclose or suggest "receiving second news content, via the network, at the custom document server from the news server based, at least in part, on the query data," "incorporating the second news content into the one or more news documents" and "permitting client access, via the network, to the second news content at the custom document server," as recited in amended claim 19.

As further discussed above with respect to claim 10, column 3, line 67 – column 4, line 2 of MIYASAKA merely discloses the generation of a newspaper having content in a layout

specified by an individual recipient's profile. This section of MIYASAKA, however, does not disclose or suggest "receiving second news content, via the network, at the custom document server from the news server based, at least in part, on the query data," "incorporating the second news content into the one or more news documents" and "permitting client access, via the network, to the second news content at the custom document server," as recited in amended claim 19.

As also discussed above with respect to claim 1, column 4, lines 29-40 of MIYASAKA discloses a news server 5 that obtains documents from content provider 4, or searches for and obtains document content from databases or other repositories that are maintained by content provider 4. As disclosed in MIYASAKA, news server 5 provides a representation of a newspaper, using document content from content provider 4, to individual recipients 7, 8 or 9 based on individual scheduling preferences. This section of MIYASAKA, however, does not disclose or suggest "receiving second news content, via the network, at the custom document server from the news server based, at least in part, on the query data," "incorporating the second news content into the one or more news documents" and "permitting client access, via the network, to the second news content at the custom document server," as recited in amended claim 19.

In view of the remarks above, Applicants submit that MIYASAKA does not disclose or suggest the combination of features recited in amended claim 19. Withdrawal of the rejection of this claim is, therefore, respectfully requested.

Claims 20, 21 and 24-28 depend from claim 19. These claims, therefore, patentably distinguish over MIYASAKA for at least the reasons set forth above with respect to claim 19.

Amended independent claim 29 recites similar features to (though possibly of different scope than) features recited in claim 19. Claim 29, therefore, patentably distinguishes over MIYASAKA for similar reasons to those set forth above with respect to claim 19.

Rejections Under 35 U.S.C. §103

On page 8, the Office Action rejects claims 3, 4, 22 and 23 under 35 U.S.C. §103(a) as allegedly being unpatentable over MIYASAKA in view of STARZL. Applicants respectfully traverse and submit that the Office Action has failed to establish a *prima facie* case of obviousness with respect to claims 3, 4, 22 and 23.

As one requirement for establishing a *prima facie* case of obviousness, the reference (or references when combined) cited by the Office Action must teach or suggest all of the claim features. *In re Vaeck*, 947 F.2d 488, U.S.P.Q.2d 1438 (Fed. Cir. 1991). See M.P.E.P. § 2143. Applicants respectfully submit that MIYASAKA and STARZL, either singly or in combination, do not teach or suggest each and every feature of claim 3.

Applicants first note that STARZL does not remedy the deficiencies in the disclosure of MIYASAKA as identified above with respect to claim 1, from which claim 3 depends. Withdrawal of the rejection of claim 3 is, therefore, requested for at least this reason. Applicants further submit that MIYASAKA and STARZL do not disclose or suggest each and every feature of claim 3.

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In rejecting claim 3, the Office Action (pg. 8) admits that MIYASAKA does not disclose

"wherein the news aggregation server retrieves at least a portion of the selected news content

using the URL and generates a search query for use in the search based, at least in part, on the at

least a portion of the text," as recited in claim 3. The Office Action (pg. 8), however, alleges that

paragraph 14, lines 5-23 of STARZL discloses this feature. Applicants disagree.

At paragraph 14, lines 5-23, STARZL discloses:

> These keywords and keyphrases are automatically loaded into a query server. This
> query server utilizes many pre-existing Internet search resources (e.g., search
> engines, directories, streams, etc.) to locate web documents matching the search
> criteria. These web documents may be actual textual documents, images, pages,
> or other resources found on the Web, as well as their addresses. The system
> creates a crawl table by parsing, storing and de-duplicating the located web
> documents returned from the pre-existing Internet search resources. The system
> then uses a spider server to retrieve, from the Internet, the full-text document
> related to each item in the crawl table. The system analyzes each document
> retrieved to extract a document signature, wherein the signature is related to the
> content of the document, and then compares the signature for each document to
> predetermined signature criteria related to that topic to determine the relevancy of
> each document to that topic.

This section of STARZL discloses that a query server uses keywords and keyphrases of a search

query to locate web documents that match the keywords and keyphrases, and then retrieves full-

text documents that correspond to each of the web documents that match the keywords or

keyphrases. This section of STARZL, thus, merely discloses use of keywords or keyphrases of a

search query for searching web documents to obtain documents that match the search query.

This section of STARZL does not disclose, or even suggest, user selection of news content

hosted at a news server, retrieval of a portion of text of the selected news content, and generation

of a search query for use in a search based on the retrieved portion of text of the selected news

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content. Applicants submit, therefore, that the section of STARZL cited by the Office Action does not disclose or suggest "wherein the news aggregation server retrieves at least a portion of the selected news content using the URL and generates a search query for use in the search based, at least in part, on the at least a portion of the text," as recited in claim 3. The Office Action, therefore, has failed to establish a *prima facie* case of obviousness. Withdrawal of the rejection of claim 3 under 35 U.S.C. §103 is, thus, respectfully requested.

Claim 4 depends from claim 3. Withdrawal of the rejection of claim 4 is, therefore, requested for at least the reasons set forth above with respect to claim 3.

Claim 22 recites similar features discussed above with respect to claim 3. Withdrawal of the rejection of claim 22 under 35 U.S.C. §103 is respectfully requested for similar reasons to those set forth above with respect to claim 3.

Claim 23 depends from claim 22. Withdrawal of the rejection of claim 23 is, therefore, requested for at least the reasons set forth above with respect to claim 22.

In view of the foregoing amendments and remarks, Applicants respectfully request the Examiner's reconsideration of this application, and the timely allowance of the pending claims. To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

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